

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 128-137 and 145-150 are pending after entry of the amendments set forth herein.

Claims 128-137 and 145-150 were examined. Claims 128-137 and 145-150 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

Claims Rejected Under 35 U.S.C. Section 112, Second Paragraph

In the Official Action of June 9, 2008, claims 131, 145 and 149 were rejected under 35 U.S.C. Section 112, second paragraph as being indefinite. The Examiner asserted that the recitation of “the shape of a cowboy hat” was indefinite. Although Applicants do not agree and do not acquiesce thereto, as it is respectfully submitted that the specification defines the shape of a cowboy hat by reference to Fig. 16 and the description thereof, Applicants have nevertheless canceled this recitation from the claims in order to advance the prosecution of the instant application.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 131, 145 and 149 were rejected under 35 U.S.C. Section 112, second paragraph as being indefinite, as being moot.

Claims Rejected Under 35 U.S.C. Section 102(b) (Taylor et al.)

Claims 128-129 and 148 were rejected under 35 U.S.C. Section 102(b) as being anticipated by Taylor et al, U.S. Patent No. 6,036,641.

Regarding claims 128 and 148, the Examiner asserted that Taylor et al discloses a device 1 (Fig. 8) having a contact member 1 that includes upwardly at an outer perimeter portion shown at reference

43 and at an outer perimeter 41.

Applicants have amended claims 128 and 148 above to clarify that the contact surface angles from an exterior portion thereof to an interior portion thereof. The contact surface 4 of Taylor et al. is flat, substantially planar, and not inclined, although it may include notches 44 to allow space for the target artery. Nevertheless, these notches 44 are also not inclined from an interior portion to an exterior portion. Examples of the contact surfaces are clearly shown as being flat and not inclined, e.g., see Fig. 1C. As to the Examiner's comments, reference numeral 43 refers to the shaft that is connected to the contact member 1 and is clearly not a contact surface. Likewise, reference numeral 41 is also clearly not a contact surface, as it refers to the annular contact member overall, e.g., see column 17, line 23.

Regarding claim 147, it is respectfully submitted that Taylor et al. does not disclose a device for providing additional stabilization to tissue already in contact with a primary stabilization member. Furthermore, 42 is not the lower surface of the annular contact member 41, contrary to the Examiner's assertion. Rather, reference numeral 42 refers to a lockable fixture that engages the end of shaft 43, e.g., see column 17, lines 6-8. Still further, the contact member 41 cannot contact tissue with an interior portion of its lower surface while contacting a primary stabilization member with an outer perimeter portion of its lower surface, because its lower surface is planar and it is a rigid element.

It is respectfully submitted that claim 129 is allowable for at least the same reasons provided above with regard to claim 128, since claim 129 depends therefrom.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 128-129 and 148 under 35 U.S.C. Section 102(b) as being anticipated by Taylor et al, U.S. Patent No. 6,036,641, as being clearly inappropriate.

Claims Rejected Under 35 U.S.C. Section 103(a) (Taylor et al.)

Claims 130-131, 145 and 149 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al., U.S. Patent No. 6,036,641. The Examiner asserted that it would have been obvious to modify the device of Taylor et al. to make the base member of a substantially oval-shape and canting upwardly at an outer perimeter as this would be merely a design choice.

Applicants strongly traverse. The inclination of the contact surface of the present invention serves a distinct function, to allow the outer portion to contact the primary stabilization device while the inner portion can still contact the tissue to be stabilized. Accordingly, this is not a "mere design choice", contrary to the Examiner's indication.

Further, Taylor et al. does not disclose or suggest a device for providing additional stabilization to tissue already in contact with a primary stabilization member and there would therefore have been no motivation to modify Taylor et al. as suggested by the Examiner, absent an improper, hindsight motivation gathered from a reading of the present specification and a desire to reject the present claims.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 130-131, 145 and 149 under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al., U.S. Patent No. 6,036,641, as being clearly inappropriate.

Claims Rejected Under 35 U.S.C. Section 103(a) (Taylor et al. in view of Borst et al.)

Claims 132-137, 146 and 150 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al., U.S. Patent No. 6,036,641 in view of Borst et al., U.S. Patent No. 5,836,311. The Examiner asserted that Taylor et al. discloses the invention substantially as claimed. For at least the reasons mentioned above under the grounds of rejection of claims 128-129, Applicants respectfully traverse.

It is further noted that, like Taylor et al., Borst et al. also fails to disclose or suggest a device for providing additional stabilization to tissue already in contact with a primary stabilization member and there would therefore have been no motivation to modify Taylor et al. to include a contact surface as claimed.

With regard to claim 146, it is respectfully submitted that neither Taylor et al. nor Borst et al., whether taken separately or in any proper combination, discloses, teaches or suggests at least one tissue contact member adapted to be placed on the tissue in an area bounded by primary tissue contact members, wherein said at least one tissue contact member has a contact surface that inclines upwardly towards an outer perimeter thereof.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 132-137, 146 and 150 under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al., U.S. Patent No. 6,036,641 in view of Borst et al., U.S. Patent No. 5,836,311, as being clearly inappropriate.

Borst et al. shows a contact member 81 and connecting member 80 and that it would have been obvious to make the contact member of Borst et al. in the form of a continuous loop depending on the

surgery performed, as taught by Wright. Applicants respectfully disagree, since Borst et al. specifically teaches away from forming the contact member 81 as a continuous ring. Referring to column 7, lines 44-47, Borst et al. discloses that the opening 83 permits the suction head 81 to be removed from around the grafted artery. Accordingly it is respectfully submitted that it would not have been obvious to make the suction head 81 as a continuous loop, as suggested by the Examiner, because this would destroy the ability to remove the suction head 81 from around the grafted artery.

Further, Applicants have amended claim 128 above to further recite that the contact member inclines upwardly at a perimeter portion thereof. It is respectfully submitted that neither Borst et al. nor Wright teaches or suggests this feature.

Accordingly, in view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 128-130 and 132-134 under 35 U.S.C. Section 103(a) as being unpatentable over Borst et al., U.S. Patent No. 5,836,311 in view of Wright, U.S. Reissue Patent No. RE38,814, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 103(a) (Taylor et al. in view of Wright)

Claim 130 was were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al, U.S. Patent No. 6,036,641 in view of Wright, U.S. Reissue Patent No. RE38,814. The Examiner asserted that the contact member of Taylor et al. has a circular shape and that it would have been obvious to construct the contact member of Taylor et al. in the form of a continuous loop, as taught by Wright.

Applicants have amended claim 128 above to further recite that the contact member inclines upwardly at a perimeter portion thereof. It is respectfully submitted that neither Taylor et al. nor Wright teaches or suggests this feature. Accordingly, it is respectfully submitted that claim 130 patentably defines over the cited references for at least the same reasons, since claim 130 depends from claim 128.

Accordingly, in view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 130 under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al, U.S. Patent No. 6,036,641 in view of Wright, U.S. Reissue Patent No. RE38,814, as being inappropriate.

Allowed Claims

Applicants wish to extend their appreciation to the Examiner for the indicated allowance of claims 145-147 and 149.

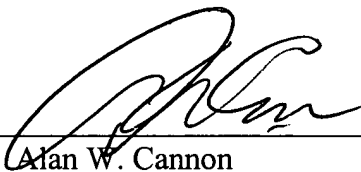
Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-021DIV.

Respectfully submitted,
LAW OFFICE OF ALAN W. CANNON

Date: 9/9/08

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